

RECEIVED  
CENTRAL FAX CENTER

FEB 20 2007

Patent

112.P14191

**BEST AVAILABLE COPY****REMARKS**

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-20 are pending in the application. Claims 17-20 have been amended. The amendment is fully supported by the original disclosure. No new matter has been introduced. The above amendments were made to clarify Assignee's claims and do not narrow the scope of the amended claims. In light of this, Assignee asserts that no prosecution history estoppel should result from the above amendments.

**Claim rejections – 35 USC §101**

Claims 1-12 and 17-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Per a telephone conference with the Examiner on February 16, 2007, an Attorney for the Assignee proposed amending independent claim 17 to recite "A computer readable storage medium having stored thereon instructions, that, if executed by a computer, perform a method comprising". The Examiner indicated that such an amendment to explicitly recite execution by computer would directly overcome the rejection to claims 17-20 and likewise indirectly overcome the rejection to claims 1-12, as the rejection to claims 1-12 was inferentially based on claims 17-20 being improper.

112.P14191

**BEST AVAILABLE COPY**Patent**Claim rejections – 35 USC §112**

Claims 17-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Assignee respectfully submits that claims 17-20 as amended comply with the written description requirement. While the Examiner has asserted that the specific language used in the preamble of claim 17 is not identically duplicated in the specification, Assignee submits that there is no requirement that the claim language be identically present in the specification:

While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure. (See MPEP 2163 I. B.)

Information which is well known in the art need not be described in detail in the specification. See, e.g., *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379-80, 231 USPQ 81, 90 (Fed. Cir. 1986). (See MPEP 2163 II. A. 2.)

Here, the Examiner has not established that the express, implicit, or inherent disclosure of the specification is insufficient for persons skilled in the art to recognize in the original disclosure a description of the invention defined by claims 17-20 as amended. Conversely, the specification recites operation of a method via a central processing unit (CPU) of a host computer 38 at page 7, lines 15-19, for example. Even the MPEP at 2106.01 I. recognizes that computer operations are carried out by "computer-readable medium encoded with a data structure". Assignee contends that persons skilled in the art would likewise recognize the fundamental relation of programs, computer readable mediums, and processing units in a computer. Accordingly, it is respectfully requested that Examiner withdraw this ground for rejection.

It is noted that claimed subject matter may be patentably distinguished from the cited references for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by

112.P14191

Patent

the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

**BEST AVAILABLE COPY**

112.P14191

FEB 20 2007

**BEST AVAILABLE COPY**

Patent

Conclusion

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3703.

Invitation for a Telephone Interview

The Examiner is invited to call the undersigned attorney, James J. Lynch, at (503) 439-6500 if there remains any issue with allowance.

Respectfully submitted,  
Attorney for Assignee

Dated: February 20, 2007

/James J. Lynch Reg. No. 50,153/  
James J. Lynch  
Reg. No. 50,153

Customer Number: 00043831

Berkeley Law & Technology Group, LLP  
1700 NW 167<sup>th</sup> Place, Suite 240  
Beaverton, OR 97006  
503.439.6500